

Applicant(s) : Yee Mau CHEN and Sum Fat POON
U.S. Serial No.: 10/776,971
Filed : February 11, 2004
Page : 7

Remarks

Applicants have amended claims 14, 15, 22, 24, 27, and 28. Support for amended claims 14 and 24 may be found inter alia in paragraph 0029 of the published application. Claims 15 and 28 have been amended for clarity. No new matter has been added. Accordingly, Applicants respectfully request the Examiner to enter the amendments.

Objection under 37 CFR 1.83(a)

The Examiner objected to the drawings under 37 CFR 1.83(a). The Examiner states that "[t]he drawings must show every feature of the invention specified in the claims. Therefore, the pivotally connected mesh of claims 22 and 27 must be shown or the feature(s) canceled from the claim(s)."

In response, Applicants respectfully traverse the above ground for rejection. Applicants maintain that the claims are clear without the drawings. Specifically, applicants have clearly recited the uses of the mesh and the connection to a hinge:

"But the use of a mesh is optional. The mesh is designed to contain the coffee grounds or beverages mixes within the beverage or coffee receiving container during and after brewing. The mesh can be completely detachable or connected to the beverage or coffee receiving container using a hinge. See Page 7, lines 23-25, specifications."

A person of ordinary skill in the art can add the hinge anywhere as long as it does not affect the brewing process. Therefore, it is not necessary to amend the drawings to show that feature. Accordingly, Applicants respectfully request the Examiner to withdraw this ground of objection.

Applicant(s) : Yee Mau CHEN and Sum Fat POON
U.S. Serial No.: 10/776,971
Filed : February 11, 2004
Page : 8

Rejection under 35 USC 102(e)

The Examiner rejected claims 14-20, 23-25, and 28 under 35 USC 102(e) as being anticipated by Cai. The Examiner states that "[t]here is disclosed in Cai a brewing apparatus, comprising: a handle (fig. 1); attached to a receiving or brewing container 10; a filter 12; an outlet nut 23 fixed to the container; and a foam maker 20 attached to the outlet nut."

In response, Applicants note that Cai fails to anticipate the claims as amended. For instance, Cai fails to disclose a foam maker having a "bottom." Although the cyclone channel of Cai has a upper portion and a lower portion, it does not have a "bottom" within the meaning of Applicants' disclosure. Accordingly, Applicants respectfully request the Examiner to withdraw this ground of rejection.

Rejection under 35 USC 103(a)

The Examiner rejected claims 21, 22, 26, and 27 under 35 U.S.C. 103(a) as being unpatentable over Cai in view of Wai. The Examiner states that "Wai discloses that it is known in the art to have a pivotally connected and detachable mesh member attached to the container of the brewing apparatus." On this basis, the Examiner concludes that "[i]t would have been obvious to one skilled in the art to provide the apparatus of Cai with the mesh member disclosed in Wai, in order to filter particles from infusion water."

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)). If

Applicant(s) : Yee Mau CHEN and Sum Fat POON
U.S. Serial No.: 10/776,971
Filed : February 11, 2004
Page : 9

the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. Manual of Patent Examining Procedure, §2142.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. Manual of Patent Examining Procedure, §2143.

In response, Applicants note, as discussed *supra*, that Cai fails to disclose all the elements of the claims as amended. For instance, Cai fails to disclose a foam maker having a "bottom." Therefore, the Examiner has failed to establish a prima facie case of obviousness, and thus, Applicants are not required to submit evidence of nonobviousness. Accordingly, Applicants respectfully request the Examiner to withdraw this ground of rejection.

Allowable Subject Matter

Applicants acknowledge that the Examiner has allowed claims 29-32.

If a telephone interview would be of assistance in advancing the prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Applicant(s) : Yee Mau CHEN and Sum Fat POON
U.S. Serial No.: 10/776,971
Filed : February 11, 2004
Page : 10

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,

Albert Wai Kit Chan

Albert Wai-Kit Chan
Registration No. 36,479
Attorney for Applicants
World Plaza, Suite 604
141-07 20th Avenue
Whitestone, New York 11357
Tel: (718) 799-1000
Fax: (718) 357-8615
E-mail: chank@kitchanlaw.com

I hereby certify that this
Amendment is being facsimile-
transmitted to:

Examiner Reginald Alexander
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Fax No.: (571) 273-8300

on the date shown below.

Albert Wai Kit Chan 5/4/06
Albert Wai-Kit Chan Date
Reg. No. 36,479